

REMARKS

This Amendment responds to the Office Action dated May 3, 2006. Claims 31, 32 and 34-59 are pending after entry of the amendment. Of these, claims 31, 32 and 55-59 are withdrawn from consideration pursuant to a restriction requirement and an election of species requirement.

Election of Species Requirement

Applicant affirms the election of species B. Claims 34-53 read on this species.

Applicant notes that claims 51-53 had been inadvertently marked as having been withdrawn by the examiner in the previous action and then by Applicant in the previous amendment. These claims read on the elected invention and species and should be considered substantively by the examiner.

Rejection under 35 U.S.C. 112

The Examiner rejected claims 42-45 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The examiner's objection is based on the alleged lack of disclosure of the particular length of small intestine to be bypassed or where the pylorus is in relation to the device.

The Examiner's reading of the requirements of section 112 is incorrect; the specification has adequate support for Applicant's claims. Claim 42 recites a bypass of most of the small intestine, while claim 43 recites a bypass of only a portion of the small intestine. The specification and drawings provide completely adequate support for this subject matter. Furthermore, there is no requirement under section 112 or any other portion of the patent statute to provide a definition of a common anatomical feature such as the pylorus. Applicant's use of that term in the specification and claims is adequate support for claims 44 and 45. The rejection under section 112 is inappropriate and should be withdrawn.

Rejections under 35 U.S.C. § 102

The Examiner rejected claims 34-41, 43-47, 49, 50 and 54 under 35 U.S.C. § 102(e) as being anticipated by Stack et al. US 2005/0004681 ("Stack"). Independent claim 34 has been amended to further define the invention by reciting a diversion of a portion of the food through the bypass while

permitting a remaining portion of said food to flow through the intestinal tract without passing through the bypass. Stack does not disclose this method step. Instead, Stack's device delivers all food leaving the stomach beyond the proximal portion of the small bowel. Furthermore, Stack never adjusts the size of the device pathway to divert a portion of the food to a bypass. Claim 34, and claims 35-41, 43-47, 49, 50-54 depending from claim 34, are therefore patentable over Stack under § 102(e).

The Examiner rejected claims 34-40 and 46-50 under § 102(e) as being anticipated by Bessler US 2004/0039452 ("Bessler"). Bessler's device does not perform the recited step of regulating the portion of food diverted to the intestinal bypass by adjusting a cross sectional lumen size of the adjustable intestinal pathway. Rather, Bessler discloses a gastric bypass through which *all* ingested food flows. Claim 34, and claims 35-40 and 46-50 depending from claim 34, are therefore patentable over Bessler under § 102(e).

Amendment to claim 52

Applicant has amended claim 52 to clarify the invention.

CONCLUSION

Applicants submit that the instant application is in condition for allowance. Should the Examiner have any questions, the Examiner is requested to contact the undersigned attorney.

The Commissioner is authorized to charge any additional fees which may be required, including petition fees and extension of time fees, to Deposit Account No. 23-2415 (Docket No. 32344-701.201).

Respectfully submitted,

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